

REMARKS

Applicant has cancelled claims 1 and 2 and amended claim 3. Applicant has added new claims 6 and 7. The amended claim and new claims are supported by the as-filed specification, e.g., ¶¶ [0021], [0022], [0024], [0038-0041]. No new matter has been introduced. Claims 3-7 are pending.

Based on a recent telephone conference with the Examiner, Applicant understands that the Examiner has considered the Chinese Office Action dated September 5, 2008 submitted in the Information Disclosure Statement filed December 4, 2008. Applicant respectfully requests that in the next written communication, the Examiner include a complete initialed Form PTO/SB/08 noting the consideration of the September 5, 2008 Chinese Office Action. For the Examiner's convenience, attached is a Form PTO/SB/08 citing the previously submitted September 5, 2008 Chinese Office Action.

Applicant has amended the as-filed specification to remove the references to the claims in the "Summary of the Invention" section. Applicant therefore requests withdrawal of the objection to the specification.

The Office Action rejected claims 1-3 under 35 U.S.C. §112, second paragraph for containing asserted informalities. The rejection of claims 1 and 2 under 35 U.S.C. § 112, second paragraph is obviated by the cancellation of these claims. Amended claim 3 now depends from new claim 6. New claim 6 does not contain the asserted informalities and includes the suggested claim language noted at pages 2-3 of the Office Action. Applicant therefore respectfully requests withdrawal of the rejection of claim 3 under 35 U.S.C. § 112, second paragraph.

The Office Action rejected claims 1-3 under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the enablement requirement. Specifically, the Office Action at pages 3-4 asserted that while ¶¶ [0022]-[0024] of the specification purportedly indicate that the concentration of the claimed metallic particles and the thickness of the claimed resin-metal composite layer are critical to practice the claimed invention, these parameters are not recited in the claims. The rejection of claims 1 and 2 under 35 U.S.C. § 112, first paragraph is obviated by the cancellation of these claims. Amended claim 3 now depends from new claim 6. New claim 6 recites the above-mentioned parameters, i.e., “wherein [a] resin-metal composite layer is from 20 to 2000 nm in thickness; and [a] concentration of ... metallic particles is from 20 to 90%(v/v) in the resin-metal composite layer.” Since new claim 6 complies with the enablement requirement under 35 U.S.C. § 112, first paragraph, Applicant respectfully requests withdrawal of the rejection of claim 3 under 35 U.S.C. § 112, first paragraph.

Applicant respectfully requests reconsideration of the rejection of claims 1-3 under 35 U.S.C. §102(b) over U.S. Patent Application No. 2002/0018886 to Matsufuji et al. (“Matsufuji”) for at least the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is disclosed, either expressly or inherently, in a single prior art reference. M.P.E.P. §2131.

New claim 6 recites, among other things, “[a] resin substrate having a resin-metal composite layer on a surface of the resin substrate, the resin-metal composite layer comprising reduced metallic particles dispersed in a resin matrix.” The as-filed specification at, e.g., ¶¶ [0038-0041] supports the above-mentioned features. This portion of the specification describes an example in which a resin-metal composite layer

is produced. A layer having a polar group modified on the surface of the resin substrate is brought into contact with a metal compound solution. This metal compound solution diffuses and penetrates from the surface into the inside of the modified layer and then either metal colloids or ions in the metal compound solution bind to the polar group. Accordingly, metal compound is reduced to become fine metal particles of nano level in the resin-metal composite layer.

Matsufuji does not disclose expressly or inherently “[a] resin substrate having a resin-metal composite layer on a surface of the resin substrate, the resin-metal composite layer comprising reduced metallic particles dispersed in a resin matrix,” as recited in claim 6. Matsufuji instead teaches inorganic particles in form of metal oxides that are surface-treated. For example, Matsufuji specifically teaches that because of poor compatibility between the inorganic particles, such as metal oxide particles, and a binder polymer, it is necessary to treat the inorganic particles with a surface treatment agent containing an organic segment in order to form a bonding with the binder polymer. See ¶¶ [0100], [0103] of Matsufuji.

Since Matsufuji fails to disclose all of the features of new claim 6, new claim 6 is not anticipated by Matsufuji. Amended claim 3 and new claim 7 depend from new claim 6 and incorporate all of the features of new claim 6. Accordingly, amended claim 3 and new claim 7 are not anticipated by Matsufuji for at least this reason.

Moreover, new claim 7 recites, among other things, that “metallic particles comprise metal particles selected from the group of precious metals.” The written support for the new claim 7 can be found in the as-filed specification, e.g., at ¶ [0021]. Matsufuji, in contrast, discloses using base metals, e.g., at ¶ [0100], but does not

disclose using precious metals. Matsufuji thus fails to disclose all of the features of new claim 7 and does not anticipate new claim 7.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Attachment: Form PTO/SB/08 citing a previously submitted reference